

REMARKS

I. Status of the Claims

Claims 1-31 are pending in this application. No claims are presently amended.

II. Double Patenting Rejections

Claims 1-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-47 of U.S. Patent No. 5,945,095 to Mougin et al. ("the '095 reference") and over claims 1-21 U.S. Patent No. 6,361,782 to Chevalier ("the '782 reference").

The analysis of an obviousness-type double patenting rejection focuses on whether the *claims* of the pending application are obvious over the claims of an issued patent. It is a well-known tenet of patent law that the analysis for such a rejection parallels that of an obviousness rejection under 35 U.S.C. 103, with the exception that the Office cannot rely on the teachings of the specification to support the assertion of obviousness. See, e.g., M.P.E.P. §804. In addition, like an obviousness rejection, the Office must describe why the pending claims would have been obvious over the patented claims at the time the present invention was filed.

The elements of a *prima facie* case of obviousness include the requirement that the cited reference(s) teaches or suggests all of the limitations of the claim at issue, and that some motivation be provided for the assertions of the Office. See M.P.E.P. § 2143. In the present case, the Office has failed to meet these requirements, thus rendering the double patenting rejection improper.

Specifically, the presently claimed composition comprises a dispersion of surface-stabilized polymer particles in a liquid fatty phase, wherein the polymer particles comprise at least 2% by weight relative to the total weight of the composition, and the composition has a viscosity, measured at 25°C, at a shear rate of 200 s⁻¹, ranging from 2 Pa·s to 17 Pa·s. As admitted by the Office, the claims of the '095 and the '782 patents do not teach these parameters, *i.e.*, "specific weight percentages, [or] viscosity of the polymer." Office Action at 3. However, despite this acknowledgement, the Office asserts "it would have been obvious for one of ordinary skill in the art to optimize the amounts of the polymers and adjust the viscosity of the composition of the patented claims depending on the polymer or oil or active agent so as to achieve the desired cosmetic effect." *Id.*

This conclusory statement on the part of the Office in no way rises to the level of a showing of "clear and particular" evidence for an obviousness determination as mandated by the Federal Circuit. See *In re Dembiczaik*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). In fact, the Office does not provide any support at all for the assertions made regarding obviousness. Since only the claims of the references can be relied upon to make a non-statutory double patenting rejection, it follows that the Office must be using hindsight to reach its conclusion. This is improper.

For these reasons, Applicants believe the double patenting rejections over the '095 patent and '782 patents are in error and should be withdrawn.

III. Obviousness Rejections

Claims 1-31 are rejected under 35 U.S.C. § 103(a) over EP 0 749 747 A1, relying on its U.S. equivalent, U.S. Patent No. 5,851,517 to Mougin et al. (“the ‘517 reference”), and also over the ‘782 reference discussed above. Office Action at 5-8.

‘782 Patent

As discussed by the Office on page 7 of the Office Action, a showing of common ownership of the present application and the ‘782 reference will preclude a rejection under 35 U.S.C. § 103(a) based upon the provisions of 35 U.S.C. § 102(f), (g), and/or (e) regarding common assignment for applications filed on or after November 29, 1999. See 37 C.F.R. 1.78(c). Accordingly, Applicants have herewith submitted a copy of the recorded assignment (attached as Appendix A) for the ‘782 patent, rendering the rejection thereover moot.

‘517 Patent

Turning to the ‘517 reference, the Office acknowledges that the reference “fails to teach the viscosity of the composition” recited in the present claims. See Office Action at 6. The Office, however, alleges that because the ‘517 reference “teaches the same polymers, solvents, stabilizers and other cosmetic ingredients in their composition [as claimed], the cosmetic compositions of [the ‘517 reference also] exhibit the same viscosity as claimed.” Office Action at 6. Applicants respectfully traverse the rejection.

As discussed above, to establish a *prima facie* case of obviousness, certain criteria must be met, including the requirement that the cited prior art reference must teach or suggest all the claim limitations. This requirement has not been met here. The

Office has made allegations, but, as shown below, the '517 reference simply does not teach or suggest the viscosity limitations of the present claims.

In response to the allegations of the Office, Applicants submit the Declaration Under 37 C.F.R. § 1.132 of Stephane Arditty. The Declaration presents the results of Dr. Arditty's measurement of the viscosity of the composition of Example 1 of the '517 reference using the method of measurement disclosed in the present application. Due to availability of raw materials, isododecane was used instead of heptane, but the other ingredients were the same. As noted in paragraph 9 of the Declaration, the viscosity of this composition (solids content of 24.5%), as measured using the method disclosed in the instant application, was 0.189 Pa·s. However, the instant application claims a composition with viscosity in the claimed range of 2 Pa·s to 17 Pa·s.

Accordingly, the viscosity of the '517 composition, in falling outside this range, supports Applicants' position that the '517 reference neither teaches nor suggests each and every limitation of the claimed invention. As such, this rejection is improper and Applicants request its withdrawal.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application, and the timely allowance of the pending claims.

If there is any fee due in connection with the filing of this response, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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Date: August 23, 2005

*Enclosure: APPENDIX A: Notice of Recordation and Recorded Assignment
for U.S. Patent No. 6,361,782.*